

REMARKS

Claim Status

Claims 1-67 are pending in the application. This paper amends claim 25 and adds new claims 66 and 67. Claims 1, 31, 45, 60, 62, 64, and 65 are the independent claims of the application.

Specification Amendment

The Examiner objected to the specification, requiring that the reference to U.S. Patent Application Serial No. 10/236,716 be updated to reflect the fact that that application has issued as U.S. Patent. The specification has been amended accordingly. Amendment of the specification should obviate the objection.

Art Rejections

The Office Action rejected claims 1, 2, 25, 29-32, 45, and 62-65 under 35 U.S.C. § 102(b) as being anticipated by Clise *et al.*, U.S. Patent Number 5,797,091 (“Clise” hereinafter). The Office Action also rejected claims 3-23, 26, 28, 33-42, 44, 46-55, and 57-61 under 35 U.S.C. § 103(a) as being unpatentable over Clise in view of Goldenberg *et al.*, U.S. Patent Number 6,636,197 (“Goldenberg” hereinafter). Claims 24, 27, 43, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clise and Goldenberg in view of Issa *et al.*, U.S. Patent Number 5,783,989

("Issa" hereinafter).¹ Applicants respectfully traverse these rejections and request reconsideration for the reasons discussed below.

Claims 1 and 45

Independent claim 1 is directed to a remote control transmitter for enabling a user to control remotely a security system having a base unit. Claim 45 is directed to a remote controller for enabling a user to control a security system installed in a vehicle. It appears that in rejecting these independent claims the Office Action equated the base station of the security system recited in claims 1 and 45 with "the private response center or central communication system 22" of Clise. The two concepts, however, are different.

The expression *security system* means "an electrical device that sets off an alarm when someone tries to break in." Dictionary.com, available online at <http://dictionary.reference.com>. This definition is consistent with both (1) the ordinary understanding of the expression "security system," and (2) the use of this expression throughout the present application and in the patent documents incorporated by reference in the present application. According to Clise, however, "private response centers are conventionally used to monitor intrusion detection systems, fire alarms, and the like." Clise, col. 3, lines 11-13. In other words, the private response center described in Clise monitors security systems such as intrusion detection systems and fire alarms. The private response center itself is not a security system. Therefore, Clise does not disclose that the personal communicator is a remote control transmitter for remotely controlling a *security system*.

¹ In explaining the rejection of claims 43 and 56, the Office Action referred to Clise, Goldenberg and "Flick." In attempting to justify the rejections, the Office Action simply adverted to the explanations already given with respect to claims rejected as unpatentable over Clise, Goldenberg, and Issa. Therefore, it appears that the mention of Flick was a clerical error, and that the intended references are Clise, Goldenberg, and Issa. In any event, the Office Action did not provide any reason for combining Flick with the other references, and therefore could not make out a *prima facie* case of obviousness under 35 U.S.C. § 103.

At least for this reason, Applicants respectfully submit that Clise does not anticipate independent claims 1 and 45.

Claim 31

Independent claim 31 is directed to a remote control security system installed in a vehicle. The claimed system includes a base unit with security sensors, and a remote control transmitter enabling a user to operate the base unit. Clise does not disclose a remote control transmitter for controlling a *security system*, as discussed above in relation to claims 1 and 45. Furthermore, Clise apparently does not disclose a security system installed in a *vehicle*. Still further, Clise apparently does not disclose a base unit with *security sensors*. Applicants respectfully submit that Clise does not anticipate independent claim 31 at least for these reasons.

Claim 62

Independent claim 62 is directed to a menu-driven remote control for operating a controlled system. The remote control includes a hand-held general purpose computing device, such a personal digital assistant (PDA), and a wireless communication module. The hand-held general purpose computing device includes a graphical display and a controller that displays menu items on the graphical display.

Clise discloses, among other things, that

the personal communicator 10 can be easily adapted to operate with existing communications devices. For example, *the transmitter and receiver portions (not shown) of a radio telephone or cellular telephone can be used as the transmitter 44 and receiver 46. The remaining elements, such as the position location circuit 42, button 12, display 16, sound generator 50, microprocessor controller 52, memory 54, real time clock 56, I/O port 58 are incorporated into the personal communicator 10 for use with the existing communications device. The battery 62 can supply power to the personal communicator 10. Alternatively, the existing communications device*

can provide power to the personal communicator 10 in a conventional manner. Thus, the personal communicator 10 can be added on to existing communications devices to reduce the number of devices that an individual must carry with him.

Clise, col. 8, line 60 through col. 9, line 9 (emphasis added). Assuming that the telephone is a “hand-held general purpose computing device,” Clise still does not anticipate claim 62. In contrast to the remote control of claim 62, the controller of the telephone disclosed in Clise does not display menu items on the display of the telephone. As the emphasized verbiage in the above quotation makes clear, only the transmitter and receiver portions of the telephone are used in the communicator. The display of the telephone apparently is not used.

Note also that in claim 62, the wireless communication portion is an element separate from the general purpose computing device. In Clise, however, the transmitter and receiver of the telephone (which is presumably the “hand-held general purpose computing device”) are used in the communicator. According to Clise, the general purpose computing device provides only the transmitter and receiver; according to claim 62, the general purpose computing device provides elements other than the transmitter and receiver.

Applicants respectfully submit that Clise does not anticipate independent claim 62 at least for these reasons.

Claim 64

Independent claim 64 is directed to a remote control security and entertainment system installed in a vehicle. The claimed system includes a base unit with security sensors and a video entertainment module, and a remote controller enabling a user to operate the base unit. Clise does not disclose a remote control transmitter for controlling a *security system*, as discussed above in relation to claims 1 and 45. Furthermore, Clise apparently does not disclose a security system

installed in a *vehicle*. Still further, Clise apparently does not disclose a base unit with *security sensors*. Additionally, Clise apparently does not disclose a base unit with a *video entertainment module*. Applicants respectfully submit that Clise does not anticipate independent claim 64 at least for these reasons.

Claim 65

Independent claim 65 is directed to a remote control security and positioning system installed in a vehicle. The claimed system includes a base unit with security sensors and a global positioning module, and a remote controller enabling a user to operate the base unit. Clise does not disclose a remote controller for controlling a security system, as discussed above in relation to claims 1 and 45. Furthermore, Clise apparently does not disclose a security system installed in a *vehicle*. Still further, Clise apparently does not disclose a base unit with *security sensors*.

While Clise does disclose a global positioning system (GPS), the global positioning system is installed in the personal communicator, *not in a base unit*. According to Clise, “[t]he personal communicator 10 thus provides several alternative techniques for generating position data.” Clise, col. 7, lines 63-64; *see also* Clise, Figure 4 (showing a GPS receiver in the communicator) and Figure 5 (showing the communicator in communication with GPS satellites); *id.*, col. 2, lines 41-45; and *id.*, col. 5, lines 51-53 (“The position data is generated by the position location circuit 42 . . . within the housing 40 of the personal communicator 10.”). Thus, Clise does not disclose a base unit with a positioning system.

Applicants respectfully submit that Clise does not anticipate independent claim 65 at least for these reasons.

Claims 3, 26, 33, 46, and 60

In rejecting independent claim 60 and dependent claims 3, 26, 33, and 46, the Office Action acknowledged that Clise fails to disclose a scroll wheel with an internal push-to-activate switch operable by depressing the scroll wheel in a radial direction of the scroll wheel toward center of the scroll wheel and releasing the scroll wheel. The Office Action then sought to combine Clise with Goldenberg to overcome this admitted deficiency in Clise's disclosure. According to the Office Action, Goldenberg suggests a "scroll control knob/wheel 26." In Goldenberg, however, the numeral 26 designates a knob, not a scroll wheel. See, for example, Goldenberg, column 5, lines 6-9. A *knob* is not the same as a *scroll wheel*.

One dictionary defines a *knob*, in the relevant part, as a "rounded lump or protuberance, esp. at the end or on the surface of a thing." OXFORD UNIVERSITY PRESS, THE NEW SHORTER OXFORD ENGLISH DICTIONARY (CD-ROM ed. 1996). Goldenberg's knob 26 appears to be such a conventional knob. In contrast, a *scroll wheel* in the computer context is "a hard plastic or rubbery disc on a computer mouse that is perpendicular to the mouse surface." Wikipedia Encyclopedia, available online at http://en.wikipedia.org/wiki/Scroll_wheel.² A scroll wheel is a disc, not a knob, protuberance, or cylindrical object disclosed in Clise.

Moreover, Goldenberg apparently does not disclose or suggest that the knob 26 may be *rotated by the thumb of the same hand that is holding the controller*. Even if the communicator disclosed in Clise is "sized to fit easily in one hand of the user," it does not follow that the knob can be operated by the thumb of the same hand.

At least for these reasons, Applicants respectfully submit that independent claim 60 and dependent claims 3, 26, 33, and 46 are patentable over Clise and Goldenberg.

² Note that the claims do not limit the scroll wheel to any particular material composition, such as plastic or rubber.

Claims 4, 47, and 61

In accordance with dependent claims 4, 47, and 61, menu items are displayed *one at a time*. It appears that neither Clise nor Goldenberg discloses or suggests displaying menu items one at a time. Clise, for example, apparently shows displays with multiple menu items in figures 1, 3, and 5. Goldenberg apparently also shows multiple menu items displayed in Figures 1 and 4E; see also Goldenberg at column 3, lines 47-48, and at column 5, lines 53-56. At least for this reason, Applicants respectfully submit that dependent claims 4, 47, and 61 are separately patentable over Clise and Goldenberg.

Claims 5 and 48

Claim 5 recites the limitation of “wherein one of the menu items occupies no less than substantially half of the display area capable of displaying menu items.” Claim 48 recites a similar limitation. In rejecting these claims, the Office Action stated that the limitations in issue here are taught in Figures 2 and 3 of Clise, and in Figure 1 of Goldenberg. Applicants respectfully request the Examiner to review these Figures again.

Figure 2 of Clise does not show any menu items. Figure 3 of Clise shows a display 16. Assuming that the information shown on the display 16 includes menu items, each of the items is smaller than half the display area of the display 16.

Goldenberg’s Figure 1 shows a display 14 with a number of menu items, each of which appears to be smaller than half the display area. For example, the cursor 34 rests on the item “K,”

which appears to be the same size as items “A” through “J” and “L” through “P”; all of the items “A” through “P” fit on the display area at the same time.

At least for this reason, Applicants respectfully submit that dependent claims 5 and 48 are separately patentable over Clise and Goldenberg.

Claims 13, 35, and 52

Claims 13, 35, and 52 recite limitations relating to screen inversion. It appears that neither Clise nor Goldenberg discloses or suggests screen inversion. At least for this reason, Applicants respectfully submit that dependent claims 13, 35, and 52 are separately patentable over Clise and Goldenberg.

Claims 15 and 36

According to claims 15 and 36, the scroll wheel is disposed on a sidewall of the outer housing and protrudes from the sidewall. It appears that neither Clise nor Goldenberg discloses or suggests such placement of the scroll wheel. Goldenberg, for example, shows in Figure 1 a knob (not a scroll wheel) protruding from the upper surface of the device 12. At least for this reason, Applicants respectfully submit that dependent claims 15 and 36 are separately patentable over Clise and Goldenberg.

Claims 16-18, 20, 21, 37-39, 41, and 54

These claims recite various size, weight, and activation pressure range limitations.

With respect to the selection of pressure needed to activate the internal switch, the Office Action asserted that this limitation “reads upon the haptic feedback scroll control knob.” If the specific pressure range is disclosed in one of the references, the disclosure should be pointed out. This has not been done. Official notice of this fact also was not taken. If this fact is considered to be so well-known as to be capable of instant and unquestionable demonstration, Applicants respectfully request that documentary evidence in support of this fact be provided in the next Office action. *See* MPEP § 2144.03(C). But at this point, the record does not indicate why a hypothetical person skilled in the art would have been motivated to select the pressure needed to activate the internal switch within the specific range claimed by Applicants.

With respect to the size limitation in claim 17, the Office Action asserted that this is a “designed choice . . . , which provides easier and convenience carried by a user.” Invocation of “design choice” does not obviate the need to provide sufficient reasoning in support of an obviousness rejection. To make a *prima facie* case of obviousness, the Office should provide reasoning why a specific feature is a “design choice” and therefore obvious. *See In re Chu*, 66 F.3d 292, 36 U.S.P.Q.2d 1089 (Fed. Cir. 1995). Such reasoning has not been provided here.

At least for these reasons, Applicants respectfully submit that a *prima facie* case of obviousness of claims 16-18, 20, 21, 37-39, 41, and 54 has not been made, and that these dependent claims are separately patentable over the references.

Claim 25

The remote control transmitter of dependent claim 25, as amended, comprises a receiver capable of receiving messages containing information from the communication module of the base unit, and providing the messages to the processor. The messages comprise alarm, status, or diagnostic data from the base unit. It appears that Clise does not teach receiving at the communicator messages that include alarm, status, or diagnostic data from the base unit. At least for this reason, Applicants respectfully submit that Clise does not anticipate dependent claim 25.

Claim 29

In rejecting dependent claim 29, the Office Action stated that one of the references teaches a data port 58 capable of receiving the code executed by the processor. Applicants understand that the specific reference adverted to is Clise.

While Clise does disclose a port 58, Clise apparently does not disclose that the code executed by the processor is received through this port. In one place, Clise states that “An optional input/output (I/O) port 58 allows the personal communicator 10 to be coupled to an external device such as a computer (not shown). The I/O port 58 can be a serial port, a parallel port, a network connector port, telephone interface, or the like.” Clise, col. 4, lines 9-14. In another place, Clise discloses that “[d]ata can also be downloaded into the phone book storage area 84 using the I/O port 58.” Clise, col. 7, lines 3-5. In still another place, Clise discloses that the port 58 can be “incorporated into the personal communicator 10 for use with the existing communications device.” Clise, col. 9, lines 1-2. Applicants have not been able to identify a specific disclosure of

downloading the *code executed by the processor* through the port. It appears that Clise does not teach this limitation.

At least for this reason, Applicants respectfully submit that Clise does not anticipate dependent claim 29.

Other Claims

The discussion above addresses rejections of all independent claims and of several dependant claims. As regards dependent claims not specifically addressed, these claims should be patentable at least for the same reasons as their base claims and intervening claims, if any.

New Claims

Applicants believe that the new claims 66 and 67 are separately patentable over the references because the references do not disclose or suggest the combinations of elements as recited in these claims

CONCLUSION

For the foregoing reasons, Applicants submit that all pending claims are allowable over the references. To discuss any matter pertaining to the instant application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a notice to this effect is earnestly solicited.

Respectfully submitted,

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